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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,739	08/07/2001	Shigehiro Miyashita	Q65752	9599

7590 07/19/2004

SUGHRUE, MION, ZINN  
MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER

ELAHEE, MD S

ART UNIT PAPER NUMBER

2645

DATE MAILED: 07/19/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/922,739

Applicant(s)

MIYASHITA, SHIGEHIRO

Examiner

Md S Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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**DETAILED ACTION**

**DETAILED ACTION**

***Response to Amendment***

1. This action is responsive to an amendment filed on 05/05/04. Claims 1-15 and 23-28 are pending. Claims 16-22 have been cancelled.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1-15 and 23-28 been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Cox et al. (U.S. Patent No. 6,256,515).

Regarding claim 23, Cox teaches in response to a communication request from a contact, referring to a directory of records, each record comprising data of a contact, to determine whether or not a connection with the contact is approved (i.e., permitted) (abstract; col.3, lines 5-37, col.4, lines 42-62, col.7, lines 16-25).

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Cox further teaches connecting a communication from the contact if the connection is approved (i.e., permitted), and discarding the communication from the contact if the connection is not approved (abstract; col.3, lines 5-37, col.4, lines 42-62).

Regarding claim 24, Cox teaches that each record comprises a phone number (abstract; col.3, lines 5-37, col.4, lines 42-49).

Regarding claim 24, Cox teaches that communication request is a p[h]one call from a contact (abstract; col.3, lines 5-37, col.4, lines 42-49).

Regarding claim 25, Cox teaches that the communication request is an e-mail address from a contact (col.9, lines 21-26).

5. Claims 27 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Weinman, Jr. (U.S. Patent No. 6,658,455).

Regarding claim 27, Weinman teaches inputting at least one record into a memory (i.e., storage unit) in a cellular telephone (i.e., mobile phone) (col.4, lines 30-49, col.5, lines 33-35, col.8, lines 19-37, col.9, lines 32-50, col.13, lines 60-65).

Weinman further teaches transmitting, via an antenna in the mobile phone, the records stored in the memory of the cellular phone to a single personal directory list (PDL) (i.e., directory server) in a communication control network (col.9, lines 32-50). (Note: antenna is inherent)

Weinman further teaches updating the records to the single personal directory list (PDL) (i.e., telephone directory server) thereby creating a subset (i.e., replica directory or records) (col.4, lines 30-49, col.9, lines 32-50).

Regarding claim 28, Weinman teaches instructing, via a cellular telephone (i.e., mobile phone), a single personal directory list (PDL) (i.e., directory server), in which a

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directory of records is stored, to restore the directory of records in the cellular telephone (col.4, lines 30-49, col.5, lines 33-35, col.8, lines 19-37, col.9, lines 32-50, col.13, lines 60-65).

Weinman further teaches retrieving the directory of records from the single personal directory list (PDL) (i.e., telephone directory server) (col.16, lines 48-55, col.17, lines 5-8).

Weinman further teaches transmitting, the retrieved directory of records to the cellular telephone (col.9, lines 32-50, col.17, lines 5-8).

Weinman further teaches uploading the transmitted directory of records to a memory (storage unit) in the cellular telephone (col.4, lines 20-24, 30-49, col.13, lines 60-65).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 5, 6, 8, 12, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii et al. (International Pub. No. GB 2251357) and in view of Cox et al. (U.S. Patent No. 6,256,515).

Regarding claim 1, Fujii teaches a radiotelephone terminal unit 31 (i.e., mobile phone) (fig.2).

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Fujii further teaches an external device 43 (i.e., directory server) remote from the radiotelephone terminal unit 31 (fig.2). (Note: the external device has storage unit which stores subscriber information, therefore, it is a directory server)

Fujii teaches a storage unit which stores subscriber information (i.e., a directory of records), each information (i.e., record) comprising data of a telephone number, a name and an address (i.e., contact) (abstract; fig.4; page 8, lines 26, 27, page 9, lines 1-9).

However, Fujii fails to teach “a communication control unit which refers to the directory to determine whether or not a requested connection of a contact to said mobile phone is permitted, and which transmits a response indicative of permission or non-permission of the connection”. Cox teaches a communication control unit which refers to the directory to determine whether or not a requested connection of a contact to the mobile phone is permitted, and which transmits a response indicative of approved or not approved (i.e., permission or non-permission) of the connection (abstract; col.3, lines 5-37, col.4, lines 42-62). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fujii to allow a communication control unit which refers to the directory to determine whether or not a requested connection of a contact to the mobile phone is permitted, and which transmits a response indicative of permission or non-permission of the connection as taught by Cox. The motivation for the modification is to have doing so in order to establish a communication link between two parties.

Regarding claim 2, Fujii teaches a storage unit which stores the directory of records, each record contains at least a name, a phone number or an address (i.e., e-mail address) of a contact, such that the directory of records stored in the directory server is a

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replica of the directory of records stored in the mobile phone (abstract; fig.4; page 8, lines 26, 27, page 9, lines 1-9).

Fujii further teaches an operation section which generates a recalling instruction (i.e., upload instruction) in response to an operation by a user of the mobile phone (abstract; fig.17; page 12, lines 1-19).

Fujii further teaches a transmitting section which transmits the subscriber information (i.e., directory of records) from the radiotelephone terminal unit to the external device (i.e., directory server) in response to the upload instruction such that the subscriber information of the radiotelephone terminal unit is stored in the external device as a replica subscriber information (fig.17; page 12, lines 1-19, page 13, lines 9-13).

Regarding claims 5 and 15 are rejected for the same reasons as discussed above with respect to claims 1 and 2.

Regarding claim 6 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Fujii teaches the requested communication is a phone call, and each record, stored in the directory of records of the external device, comprises a phone number of a contact and a non-permission flag, which is set when a phone call from the corresponding contact should not be connected and which is reset when a phone call from the corresponding contact should be connected (page 12, lines 1-19).

Regarding claims 8 and 12 are rejected for the same reasons as discussed above with respect to claims 1 and 2.

8. Claim 3, 4, 9, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii et al. (International Pub. No. GB 2251357) and in view of Cox et

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al. (U.S. Patent No. 6,256,515) and further in view of Weinman, Jr. (U.S. Patent No. 6,658,455).

Regarding claims 3, 9 and 13, Fujii teaches subscriber information (i.e., the group of records of the directory data) of the radiotelephone terminal unit includes edit flag (page 12, lines 1-19).

Fujii teaches the radiotelephone terminal unit further comprises a keypad (i.e., editing section) which edits subscriber information (i.e., the group of records) including the edit flag in response to an operation by the user (page 12, lines 1-19).

Fujii further teaches a transmitting section of the radiotelephone terminal unit which transmits the subscriber information (i.e., the records of the groups including the edit flags of the directory data) to the external device (i.e., directory server) in response to the recalling instruction (i.e., upload instruction) such that the subscriber information (i.e., group of records) is including the edit flags is stored as part of the replica subscriber information in the external device (fig.17; page 12, lines 1-19, page 13, lines 9-13).

However, Fujii in view of Cox fails to teach "edit flag". Weinman teaches voice print tag (i.e., edit flag) (col.8, lines 55-59). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fujii in view of Cox to allow edit flag as taught by Weinman. The motivation for the modification is to have doing so in order to edit the corresponding information in future.

Regarding claims 4, 10 and 14, Fujii teaches that the number of records in each group is inherently one (page 8, lines 26, 27, page 9, lines 1-3).



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9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii et al. (International Pub. No. GB 2251357) and in view of Cox et al. (U.S. Patent No. 6,256,515) and further in view of Henry et al. (International Pub. No. WO 99/65256).

Regarding claim 7 is rejected for the same reasons as discussed above with respect to claim 6. Furthermore, Fujii in view of Cox fails to teach that a mail server delivers said e-mail to said mobile phone. Henry teaches that an e-mail forwarding system (i.e., mail server) delivers the e-mail to the mobile phone (abstract; page 5, lines 21-26). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fujii in view of Cox to allow a mail server delivering the e-mail to the mobile phone as taught by Henry. The motivation for the modification is to have doing so in order to answer the inbound call as well as make outbound call to the user.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii et al. (International Pub. No. GB 2251357) and in view of Cox et al. (U.S. Patent No. 6,256,515) and further in view of Beach (U.S. Pub. No. 2001/0055283).

Regarding claim 11 is rejected for the same reasons as discussed above with respect to claim 5. Furthermore, Fujii in view of Cox fails to teach "operation section generates a download instruction in response to an operation by a user of said mobile phone, and said transmitting section transmits said download instruction to said external unit". Evans teaches that the operation section generates a download instruction in response to an operation by a user of the mobile phone, and the transmitting section transmits the download instruction to the external unit (abstract; fig.4; page 2, paragraph 0023). Thus, it would have been obvious to one of ordinary skill in the art at the time the

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invention was made to modify Fujii in view of Cox to allow the operation section generating a download instruction in response to an operation by a user of the mobile phone, and the transmitting section transmits the download instruction to the external unit as taught by Evans. The motivation for the modification is to have doing so in order to send and receive messages using radio module.

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nordeman (U.S. Patent No. 6,134,450) teach Method of initializing a mobile communication device for making a dispatch call.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S Elahee whose telephone number is (703) 305-4822. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*M.E.*

MD SHAFIUL ALAM ELAHEE  
July 11, 2004

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

